PATENT
Customer No. 22,852
Attorney Docket No. 10022-0001-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Robert N. MILMAN et al.	)	Group Art Unit: 3629
	)	
Application No.: 09/724,268	)	Examiner: John Weiss
	)	
Filed: November 28, 2000	)	
	)	
For: METHOD AND SYSTEM FOR PROVIDING REAL ESTATE INFORMATION USING A COMPUTER NETWORK, SUCH AS THE INTERNET	)	Confirmation No.: 7895

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO OFFICE ACTION OF JANUARY 22, 2007

Applicants file this Response to the most recent Office Action, along with a Request for an Extension of 3 months and the extension fee of $ 1,020.00.

On January 19, 2007, the Examiner issued an Office Action in which the Examiner objected to Applicant's Amendment of February 21, 2006 on the alleged basis that the amendment introduced new matter into the disclosure of the invention. According to the Office Action, the new matter was "the addition of new drawings with the disclosure associated with the new drawings." ["The subject matter which is considered to be new matter must be clearly identified by the examiner." M.P.E.P. § 608.04.] As explained below, that alleged new matter is included in the provisional application, incorporated by reference into the formal application when it was filed. The Office Action also contained the broad conclusion that all of the newly

added claims were not supported by the specification originally filed on November 28, 2000 and therefore stated that "there are no claims examined in this office action." As explained below, that conclusion is also incorrect.

The Examiner in the Office action provided no explanation of the factual bases of his conclusions or the reasons why he provided no substantive analysis of the amendment and the claims, other than two short paragraphs, including only three conclusive sentences. The Examiner failed to address the comments and explanations contained in the amendment of February 21, 2006, which clearly explained that the drawings and subject matter, added by Amendment into the formal application, were taken from Applicant's provisional application, which was expressly identified and incorporated by reference in the formal application. The Examiner made no comparison of the claimed subject matter with the disclosure contained in the originally filed formal application, let alone with the disclosure included in the incorporated-by-reference provisional application.

Nor did the Office Action even address Applicants' Response to Requirement for Information, which Applicant had filed on July 17, 2006, in response to an Office Action issued on May 16, 2006. The May 2006 Office Action had issued after the amendment of February 21, 2006. The January 2007 Office Action also failed to consider the substance of the telephone interview Applicants' representatives had with the Examiner on July 13, 2006, or the Examiner's Interview Summary that identified the issues that remained after the completion of that interview. The July 2006 interview was directed to the Office Action of May 16, 2006, the status of the case, and all issues that the Examiner, before or during the interview, identified as having any relevancy to the application and its prosecution. During the interview the Examiner and the Applicants' representatives discussed any concerns regarding new matter, and the Examiner

indicated that his "new matter" concerns had been resolved. All of the issues raised by the May 2006 Request for Information, or during the interview, were addressed either during the interview or in Applicants' Response filed on July 17, 2006.

The Examiner in his Interview Summary did not identify any "new matter" issues as remaining or otherwise outstanding. This was consistent with the issues discussed and conclusions reached during the interview. As explained in Applicants' Response, "The interview was completed after both the Examiner and the Applicants had addressed any issues or requests that they respectively concluded need to be considered to place the case in condition for examination on the merits, after a search of the prior art." That Response noted that the application at that time was several years old, and no substantive examination had occurred.

Because the Examiner's Office Action of January 19, 2007 was completely inconsistent with the substance of the interview and another example of an Office Action that declined to address the merits of Applicants' application and inventions, Applicants' representative Richard Stroup initiated a telephone conference with Supervisory Primary Examiner Mr. John Weiss. Applicants gratefully acknowledge Examiner Weiss's professional courtesies extended during several telephone conferences regarding the application and the issues. During the conferences, Mr. Stroup expressed Applicants' concerns regarding the manner in which the application had been considered and the extended time over which no search or substantive examination had been provided. Mr. Stroup suggested that the nature of the circumstances were such that a different Examiner should be assigned to the application. After considering the application, its history, and its status, Examiner Weiss agreed.

Examiner Weiss, despite his extensive duties as a Supervisory Primary Examiner who also at times serves as an acting Group Director, personally reviewed the application file and

discussed aspects of the application and issues with Mr. Stroup. When Mr. Weiss was advised that the formal application was based on and incorporated by reference a provisional application, he also ordered the provisional file. Mr. Weiss discussed the status of the prosecution with Mr. Stroup, as well as potential procedures to move the prosecution of the application forward. Through those discussions, it was agreed that Applicants were entitled to place into the formal application drawings or subject matter contained in the incorporated-by-reference provisional application, but not previously contained in the formal application, as they had done in the Amendment of February 2006. It was further agreed that Applicants were entitled to a substantive examination of pending claims 47-121 in the pending application, as opposed to in a continuation application, because none of the original claims 1-46 were ever substantively examined. It was further agreed that this application, which has been on file for almost seven years, is entitled to a prompt and substantive Office Action, without further delay.

Examiner Weiss during the conferences correctly noted that the provisional application is very voluminous, making it difficult to easily compare the contents of the provisional application with the new drawings and additions added by the Amendment of February 2006. Mr. Stroup acknowledged that the provisional and the application are large and complex and therefore require some time to review and understand. Mr. Stroup pointed out that Applicants nevertheless are entitled to a complete and prompt examination, and Examiner Weiss did not disagree. Applicants understand that it was not and is not Examiner Weiss's responsibility to perform a detailed examination of the case, given his supervisory authority and responsibilities.

Mr. Stroup explained that the amendments to the formal application made in February of 2006 had been made after carefully reviewing the provisional application and incorporating into the formal application only drawings and disclosure that were fully supported, so that no new

matter was added. Mr. Stroup noted that it was Applicants' duty not to include and claim new matter. Examiner Weiss did not disagree but did also note that at a later stage of prosecution Quality Review might in its review question whether the issue of new matter had been appropriately addressed. Examiner Weiss therefore proposed that there be a more complete submission on the new matter question, before giving the case to a new Examiner for substantive examination.

Mr. Stroup and Examiner Weiss considered options, and Examiner Weiss requested that Applicants submit a supplemental written response in which they include copies of at least portions of the provisional application along with a written response regarding how the amended drawings and subject matter are supported by the provisional application. Examiner Weiss also suggested that Applicants briefly discuss independent claim 46 to explain the subject matter of that claim and its supporting disclosure. Examiner Weiss indicated that, if Applicants addressed these issues in a supplemental response, he would then reassign the application to a new Examiner and take steps to promote the prompt, substantive examination of the application. Applicants greatly appreciate Examiner Weiss's review and suggestions and are submitting this written response to move prosecution forward.

February 2006 Amendment of Drawings, Specification, and Claims

After the responsibility for the prosecution of this application was transferred to the undersigned and his firm, Applicants reviewed the provisional and formal applications and concluded that it would be beneficial if additional portions of the provisional application were incorporated into the formal application and new claims were submitted. By means of example, it was believed that this procedure would make it easier for the Examiner and the public to review the disclosure, without accessing the provisional application. During this process,

Applicants carefully reviewed the contents of the provisional application and decided to in clude some drawings of the provisional application in the formal application. Specifically, Applicants added Figs. 2A-B, 6A-C, and 20-24 to the formal application, each of those figures coming from the provisional application, as explained more fully below. Applicants included additions to the specification regarding those added Figures, those additions to the specification again being fully supported by the provisional application. Applicants also included additions to the specifications to set forth an overview of their inventions, those additions being supported by the original formal application and/or the provisional application. To assist the Examiner, Applicants also submitted a revised specification at Exhibit B of the February 2006 Amendment. In Exhibit B, the written portions added to the formal application were identified by underlining them within a complete, amended specification. A copy of that Exhibit B is included with this response.

When the February 2006 Amendment was filed, Applicants explained that the added drawings and disclosure were taken from and supported by the provisional application, and Applicants expressly and accurately explained that no new matter had been added.

Support for the Amendments to the Drawings and Specification

In response to Mr. Weiss's request, Applicants are submitting a Declaration of Mr. Robert N. Milman with this response. Mr. Milman is one of the inventors. Mr. Milman explains that each of Figs. 2A-B, 6A-C, and 20-24 are photocopies of all or portions of pages in the provisional application. Attached to his declaration at Appendix 1 are photocopies of the specific pages of the provisional application that were used to make these figures. The photocopied pages also include a marker that indicates what added Figure was based on the photocopied page of the provisional application. Mr. Milman further declares and explains that the substance of the written disclosures identified by underlining in Exhibit B (the portions added

by the February 2006 Amendment) were taken from and are contained in the provisional application and/or the original formal application. Often the underlined disclosures describe what is shown in the drawings or are expressly taken from the pages from which the new Figures were created. At other times the underlined disclosures are supported by either the provisional application, or the original drawings, disclosures, or claims, or by a combination of these. Samples of exemplary pages from the provisional application that support the added subject matter are included at Appendix 2 of Mr. Milman's declaration. The exemplary pages are organized by topics generally, including Buyer Web Site Creation, Property List Preparation, Property Lookup, Tagging Properties, Buyer List Preparation, Message Center, To Do List, CMA Lists, Seller Property Lookup, and Loan Report. These materials were compiled and organized to assist the Examiner in comparing the provisional application with disclosure added to the formal application, should the Examiner wish to make that comparison. The photocopied pages, however, are not meant to, and cannot, distill into a few pages all of the disclosure contained in the provisional application, and incorporated by reference into the formal application.

Applicants again represent that no new matter has been added to the drawings or specification or claims and respectfully submit that under the applicable law, each and every amendment to the specification and drawings is supported by the original formal disclosure and/or the provisional application, which was expressly incorporated by reference. Applicants further respectfully represent that the claims are supported by the original formal application and by the incorporated provisional application, that the drawings and disclosure added by the 2006 Amendment contain no new matter, and that the application as amended therefore is ready for and entitled to substantive examination.

Discussion of Independent Claim 47

In the 2006 Amendment and during the interview with Examiner Weiss, Applicants noted that new claims have been presented to better define the full scope of their invention. Examiner Weiss during a telephone interview referenced independent claim 47 and proposed that Applicants in this response briefly address that claim, apparently to assist in the examination process. Applicants therefore include the following general comments, with the recognition that all claims must ultimately be construed and examined according to the applicable law, rules, and procedures.

Applicants' provisional and formal application in combination disclose, *inter alia*, a computer-implemented method of providing real estate information to at least one real estate agent and at least one respective client of the agent, as claimed in Claim 47. The client of an agent can, for example, be a potential buyer of a property or a potential seller of a property. The real estate information is provided through a server, and that server according to the invention is connected to at least one database, such as a multiple listing service. According to the method, at least one real estate agent and one of the agent's clients is provided with access to the server. According to the method, an agent and an agent's client, while accessing the server, can review real estate information.

Under the method, affirmative actions of the agent and the client are monitored while the agent and client, respectively, are accessing the server. As previously explained in Applicants' most recent Response, the phrase "affirmative actions" in the claims refers to actions affirmatively (or positively or actively) taken by agents or clients when they are respectively accessing the server of Applicants' invention. Affirmative actions generally include inputting information, viewing information or materials, or inputting requests to the server, while on the

server, as part of the computer-implemented method of providing real estate information. The disclosure explains that under applicant's invention, agents and clients (e.g., potential buyers or sellers) access Applicants' server and then affirmative take actions in order to conduct real estate business and offer to sell and/or purchase homes. Some, but by no means all, of the disclosed and claimed affirmative actions are set forth in more detail in dependent claims including claims 52, 54, and 55, which depend from claim 47. The affirmative actions include, but are not limited to, logging in, viewing properties, and tagging properties as favorites. Of course, the broadest independent claims are entitled to a full scope of protection encompassed by the ordinary meaning of the claim language, in light of the disclosure, prosecution history, and law.

According to the method of claim 47, the server generates client-supplied real estate information in response to affirmative actions of the client (e.g., buyer or seller) as the client reviews real estate information through access to the server. According to the method, the invention further includes the step of enabling the agent, when accessing the server, to review the generated client-supplied real estate information. As explained in the specification, this enables the agent to access the server and learn about a buyer's or seller's activities and interests and thereby be more effective and efficient in real estate transactions for a client.

Without in any manner restricting the scope of protection of claim 47, the method of claim 47 as an example allows an agent to learn about affirmative actions taken by a client buyer and/or seller, such as when and how often the client is logging into the system, what properties a client is viewing when accessing the system, and what properties the client has tagged as potential favorites.

Applicants respectfully submit that the invention of claim 47 is fully supported by the original formal application, without any of the additions added by the February 2006

amendment. For example, a comparison of the not underlined portions of Exhibit B and the original drawings of the formal application with claim 47 show that this claim is supported by the original formal application, as are a wealth of other claims. Thus, Applicants respectfully submit that the Examiner was in error when he refused in the last Office Action to conduct a search and substantively examine any of the claims.

In light of the information and submissions presented in this and the previous responses of record, Applicants respectfully submit that they have complied with all outstanding requests and that they are entitled to a substantive examination, including a search of the prior art and a comparison of the art with the claimed inventions. Applicants respectfully submit that piecemeal prosecution or further formal Requirements for Information would be inappropriate, given the status of the case, the extensive history of piecemeal and non-substantive Office Actions, and the applicable law.

Applicants believe that no additional fees are due, other than the extension fee submitted. But, if any further extensions or fee payments are necessary, please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Finally, Applicants welcome a phone call from the Examiner, should the Examiner have any questions, comments, or suggestions that would promote the prompt examination of this application. The undersigned can be reached at (202) 408-4000.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 24, 2007

By: _____
Richard L. Stroup
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